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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re PATENT application of:

Applicant: Dieter Döhring  
Application No: 09/647,129  
Filing Date: September 26, 2000  
Title: METHOD OF IMPREGNATING DECORATIVE PAPERS  
Examiner: Elena Tsoy  
Art Unit: 1762  
Docket No. TURKP0114US

REPLY TO EXAMINER'S ANSWER

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The undersigned submits this reply brief in triplicate for the Board's consideration of the appeal of the Examiner's decision mailed July 16, 2003, finally rejecting claims 1, 3-5, 7 and 8 of the above-identified application.

In applicants' main brief it was pointed out that Hoover et al. has nothing to do with the production of wear-resistant laminate flooring material. Hoover et al. instead relates to tools for floor maintenance. Consequently, the skilled person would not have looked to Hoover et al. for improvements relating to the production of wear-resistant laminate flooring material. There is lacking any reason to believe that the skilled person would expect the methodology taught by Hoover et al., that is directed to the formation of floor scouring structures, to be transportable to the production of a laminate flooring material taught by Michl.

The Examiner responds by pointing out that (1) claim 1 does not relate to a method of the production of wear-resistant flooring material but to a method of impregnating paper, and (2) that Hoover et al. is relied upon not to show how to make a tool for floor maintenance but instead to show that a coating composition comprising abrasive particles in a melamine resin can be evenly sprayed over a web. Regarding the latter contention, Hoover et al. has not been found to show spraying of a composition comprising abrasive particles in a melamine resin as contended by the Examiner. While Hoover et al. mentions that many types and kinds of abrasive mineral binders can be employed (col. 4, lines 69-71), those that are mentioned in particular are "phenol-aldehyde resins, butylated urea aldehyde resins, epoxide resins, polyester resins such as the condensation product of maleic and phthalic anhydrides and propylene glycol" (col. 5, lines 6-10).

Regarding the first contention, claim 1 does relate to a method of the production of wear-resistant flooring material in that claim 1 recites a method of impregnating paper used for the production of wear-resistant laminate flooring material. However, the Examiner is correct that claim 1 does not require the a step of using the impregnated paper to produce a wear-resistant laminate flooring material.<sup>1</sup>

Notwithstanding, the issue is whether or not it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the Michl process in a manner that gives rise to the method recited in claim 1 in view of Hoover et al. This question does not hinge on whether claim 1 recites a method of production of wear-

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<sup>1</sup> It is noted that claim 8 does include a step of pressing the impregnated paper to form a panel.

resistant flooring or on a method of impregnating paper. Rather, it hinges on whether the skilled person would somehow be motivated or prompted to believe that some feature of Hoover et al. may be desirably applied to Michl so as to arrive at the subject matter of claim 1. The answer to this question is no, since Hoover et al. has nothing to do with the manufacture of wear-resistant flooring material or any similar type of product. Instead, Hoover et al. discloses a method of manufacturing low density open fibrous abrasive articles wherein an abrasive containing material onto an "extremely open structure having an extremely high void volume" (col. 1, lines 14-17). The finished result is a very open structure with many interstices between adjacent fibers remaining unfilled by the binder and abrasive particles (col. 3, lines 1-3). The voids make up at least three-quarters or four-fifths, or more, of the total volume occupied by the composite structure. This is clearly an application far remote from that of Michl which relates to laminate flooring that is obviously dense and not an "extremely open structure".

It is also noted that while Hoover et al. makes reference to uniform coverage (col. 6, lines 47-48), the result is not an even distribution. Hoover et al. states:

Even though the respective binder compositions are sprayed on the web in rather small amounts, the binder globules (containing abrasive particles in the case of the abrasive binder) collect at and adjacent at least a substantial number of points where the fibers cross in contact, thereby to form the three-dimensionally integrated structure.

Col. 7, lines 30-35. The globules are shown in Figure 1. Obviously, this would be quite undesirable in the fabrication of a flooring material of the type taught by Michl.

Regarding the issue of whether or not Hoover et al. is or is not non-analogous art, the Examiner cites *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). As noted by the Examiner, this case holds that a prior art reference must either be in the field of the applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In doing so, the CAFC commented:

Patent examination is necessarily conducted by hindsight, with complete knowledge of the applicant's invention, and the courts have recognized the subjective aspects of determining whether an inventor would reasonably be motivated to go to the field in which the examiner found the reference, in order to solve the problem confronting the inventor. We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) – in other words, common sense – in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor.

*Id.* at 24 U.S.P.Q.2d 1447. Here, like in *In re Oetiker*, common sense dictates a finding that the skilled person would not reasonably be expected or motivated to look to Hoover et al. for improving upon the teachings of Michl given the distinct differences between the products to which they relate.

It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself. *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir.1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir.1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir.1985).

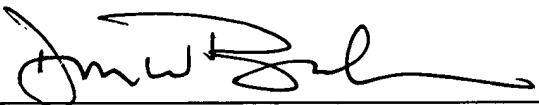
Oetiker's invention is simple. Simplicity is not inimical to patentability. See *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 64 S.Ct. 593, 594, 88 L.Ed. 721 (1944) (simplicity of itself does not negate invention); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1572, 1 USPQ2d 1593, 1600 (Fed. Cir.) (the patent system is not foreclosed to those who make simple inventions), *cert. denied*, 481 U.S. 1052, 107 S.Ct. 2187, 95 L.Ed.2d 843 (1987).

*Id.* at 24 U.S.P.Q.2d 1447. Like in *In re Oetiker*, the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness.

For the reasons discussed above and in applicant's main brief, it is respectfully submitted that the claims are patentable over the applied art and that the final rejections should be reversed.

Respectfully submitted,

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CERTIFICATE OF MAILING

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Date: May 10, 2004

  
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